

Claims 1-7, 9 and 11-20 of 09/108,447, filed as a Continued Prosecution Application, stand provisionally rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-16 of Parent Application 09/108,775. The Applicant is filing herewith a 37 CFR § 1.321(c) terminal disclaimer for the present application. Therefore, the Applicant respectfully requests that the provisional double patenting objection be withdrawn.

**REMARKS IN REGARD TO THE 35 USC§ 112**

Claim 2 is rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claim to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully thanks the Examiner for identifying these errors. Accordingly, the Applicant believes the claim 2 is now in a condition for allowance.

**REMARKS IN REGARD TO THE 35 USC§ 103 REJECTION DUBIN,**

**WO95/27017 AND SCHWAB**

Claims 1, 3-7, 9 and 10-20 stand rejected under 35 USC § 103(a) as being unpatentable over Dubin (US Patent 5,284,492) in view of WO 95/27021 and Schwab (US Patent 5,669,938).

**ARGUMENT**

Applicant respectfully suggests the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner suggests:

“It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the organic nitrate ignition improver of Schwab and the anti-freeze inhibitor of WO 95/27021 to the diesel fuel emulsion of Dubin in order to provide their known benefits.”  
(See Examiner’s Office Action Page 5 Lines 14-16.)

However, this is the incorrect standard to apply.

35 USC §103 requires the Examiner to establish a *prima facie* case for obviousness:

“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by some showing of some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988) (citations omitted)

In establishing a *prima facie* case of obviousness, the PTO “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate

the claimed invention”. *Id.* at 1600. Rather, “[t]he test is whether the claimed invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made”.

*Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (CAFC 1983).

To establish a *prima facie* case of obviousness, one of the criteria that must be met is that “the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).” MPEP Chapter 2142. (Emphasis this author’s.) The Applicant disagrees with the Examiner’s characterization of the claims. However the Applicant will address the claims as characterized by the Examiner.

**The Examiner Fails To Demonstrate That The Prior Art Teaches Or Suggests All Claim Limitations**

The threshold issue under Section 103 is whether the Examiner has established a *prima facie* case for obviousness. To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested in the prior art. MPEP § 2143.03.

The Examiner states:

“Dubin differs from the instant claims in not teaching the addition of an **antifreeze additive or an ignition delay modifier.**” (See Examiner’s Office Action Page 4 Lines 14-15.) (Emphasis added by this author.)

The Examiner then states:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the **organic nitrate ignition improver** of Schwab and the **anti-freeze inhibitor** of WO ‘021 to the diesel fuel emulsion of Dubin in order to provide their known benefits.” (See Examiner’s Office Action Page 5 Lines 14-16.) (Emphasis added by this author.)

As the Examiner states, Schwab teaches an **organic nitrate ignition improver** not an **ignition delay modifier**. Therefore, the Examiner has failed to establish a *prima facie* obviousness of the claimed invention. Applicant respectfully suggests that the Examiner has failed to establish all the claim limitations in the prior art.

**The Examiner Fails To Demonstrate That The Prior Art Teaches Or Suggests The Claimed Combination**

The Examiner concedes that Dubin does not teach all the claim limitations of the present invention.

“Dubin differs from the instant claims in not teaching the addition of an antifreeze additive or an ignition delay modifier.” (See Examiner’s Office Action Page 4 Lines 13-14.)

Therefore it is left to the Examiner to demonstrate that WO 95/27021 teaches or suggests that Dubin be combined with WO 95/27021 and Schwab, or that Schwab teaches or suggests that Dubin be combined with Schwab and WO 95/27021. The Examiner fails to demonstrate either of these scenarios.

In the first scenario, the Examiner claims that WO 95/27021 identifies the “anti-freeze inhibitor” (See Examiner’s Office Action Page 5 Lines 15) of the present invention. However, the Examiner does not provide the requisite suggestions from WO 95/27021 showing the desirability to combine the “anti-freeze inhibitor” with Dubin and Schwab to make the claimed combination. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fitch*, 23 USPQ2d 1780, 1783-84 (CAFC 1992). The Applicant respectfully requests that the Examiner show where the WO 95/27021 provides the suggestion that such a modification is desirable. Absent such a suggestion, the Examiner has improperly used hindsight to reconstruct the WO 95/27021 using the novel features provided by the present invention.

In the second scenario, the Examiner claims that Schwab identifies the “organic nitrate ignition improver” (See Examiner’s Office Action Page 5 Lines 15) of the present invention. However, even assuming the Examiner is correct (see the Prior section), the Examiner does not provide the requisite suggestions from Schwab showing the desirability to combine the “organic nitrate ignition improver” with Dubin and Schwab to make the claimed combination. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fitch*, 23 USPQ2d 1780, 1783-84 (CAFC 1992). The Applicant respectfully requests that the Examiner show where the Schwab provides the suggestion that such a modification is desirable. Absent

such a suggestion, the Examiner has improperly used hindsight to reconstruct the Schwab using the novel features provided by the present invention.

Absent such a suggestion, the Examiner has improperly used hindsight to reconstruct the Dubin, WO 95/27021 and Schwab references using the novel features provided by the present invention.

Therefore, the Applicant respectfully submits that the rejection has been traversed and the claims should be allowed.

**REMARKS IN REGARD TO THE 35 USC § 103 REJECTION PETER-HOBLYN,**

**WO 95/27017 AND SCHWAB**

Claims 1, 3-7, 9 and 10-20 stand rejected under 35 USC § 103(a) as being unpatentable over Peter-Hoblyn et al, (US Patent 5,743,922) in view of WO 95/27021 and Schwab (US Patent 5,669,938).

**ARGUMENT**

Applicant respectfully suggests the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner suggests:

“It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the organic nitrate ignition improver of Schwab and the anti-freeze inhibitor of WO 95/27021 to the diesel fuel emulsion of Dubin in order to provide their known benefits.”  
(See Examiner’s Office Action Page 5 Lines 14-16.)

However, this is the incorrect standard to apply.

35 USC §103 requires the Examiner to establish a *prima facie* case for obviousness:

“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by some showing of some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988) (citations omitted)

In establishing a *prima facie* case of obviousness, the PTO “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”. *Id.* at 1600. Rather, “[t]he test is whether the claimed invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made”. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (CAFC 1983).

To establish a *prima facie* case of obviousness, one of the criteria that must be met is that “the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination must

both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).” MPEP Chapter 2142. (Emphasis this author's.) The Applicant disagrees with the Examiner's characterization of the claims. However the Applicant will address the claims as characterized by the Examiner.

**The Examiner Fails To Demonstrate That The Prior Art Teaches Or Suggests All Claim Limitations**

The threshold issue under Section 103 is whether the Examiner has established a *prima facie* case for obviousness. To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested in the prior art. MPEP § 2143.03.

The Examiner states:

“Peter-Hoblyn differs from the instant claims in not teaching the addition of an **antifreeze additive** or an **ignition delay modifier**.” (See Examiner's Office Action Page 6 Lines 14-15.) (Emphasis added by this author.)

The Examiner then states:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the **organic nitrate ignition improver** of Schwab and the **anti-freeze inhibitor** of WO '021 to the diesel fuel emulsion of Peter in order to provide their known benefits.” (See Examiner's Office Action Page 5 Lines 14-16.) (Emphasis added by this author.)

As the Examiner identifies, Schwab teaches an **organic nitrate ignition improver** not an **ignition delay modifier**. Therefore, the Examiner has failed to establish a *prima facie*



obviousness of the claimed invention. Applicant respectfully suggests that the Examiner has failed to establish all the claim limitations in the prior art.

**The Examiner Fails To Demonstrate That The Prior Art Teaches Or  
Suggests The Claimed Combination**

The Examiner concedes that Peter-Hoblyn does not teach all the claim limitations of the present invention.

“Peter differs from the instant claims in not teaching the addition of an antifreeze additive or an ignition delay modifier.” (See Examiner’s Office Action Page 6 Lines 14-15.)

Therefore it is left to the Examiner to demonstrate that WO 95/27021 teaches or suggests that Peter-Hoblyn be combined with WO 95/27021 and Schwab, or that Schwab teaches or suggests that Peter-Hoblyn be combined with Schwab and WO 95/27021. The Examiner fails to demonstrate either of these scenarios.

In the first scenario, the Examiner claims that WO 95/27021 identifies the “anti-freeze inhibitor” (See Examiner’s Office Action Page 5 Lines 15) of the present invention. However, assuming the Examiner is correct, the Examiner does not provide the requisite suggestions from WO 95/27021 showing the desirability to combine the “anti-freeze inhibitor” with Peter-Hoblyn and Schwab to make the claimed combination. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fitch*, 23 USPQ2d 1780, 1783-84 (CAFC 1992).

The Applicant respectfully requests that the Examiner show where the WO 95/27021 provides the suggestion that such a modification is desirable. Absent such a suggestion, the Examiner has improperly used hindsight to reconstruct the WO 95/27021 using the novel features provided by the present invention.

In the second scenario, the Examiner claims that Schwab identifies the “organic nitrate ignition improver” (See Examiner’s Office Action Page 5 Lines 15) of the present invention. However, even assuming the Examiner is correct (see the Prior section), the Examiner does not provide the requisite suggestions from Schwab showing the desirability to combine the “organic nitrate ignition improver” with Peter-Hoblyn and Schwab to make the claimed combination. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fitch*, 23 USPQ2d 1780, 1783-84 (CAFC 1992). The Applicant respectfully requests that the Examiner show where the Schwab provides the suggestion that such a modification is desirable. Absent such a suggestion, the Examiner has improperly used hindsight to reconstruct the Schwab using the novel features provided by the present invention.

Absent such a suggestion, the Examiner has improperly used hindsight to reconstruct the Peter-Hoblyn, WO 95/27021 and Schwab references using the novel features provided by the present invention.

Therefore, the Applicant respectfully submits that the rejection has been traversed and the claims should be allowed.

### **CONCLUSION**

The Applicant respectfully submits that the Examiner has not met his burden of identifying the identical invention in as complete detail as is contained in the claim.

Because the Examiner failed to meet his mandatory burden of demonstrating of identifying the elements be arranged as required by the claim, the Applicant respectfully submits that the rejection is unsupported by prior art suggested by the Examiner.

For the above reasons, Applicant respectfully submits that the 35 USC 102 rejection has been successfully traversed and that the rejection based upon the prior art suggested by the Examiner is improper and should be withdrawn. Applicant respectfully requests that claims 1-13 be allowed.

No additional fee is due.

On the basis of the above remarks, early consideration of this application and early allowance are respectfully requested.

Respectfully,

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